

AUG 23 2007

Patent Application
U.S. Application No.: 10/022,438
Attorney Docket No.: 52493.000230

REMARKS

The Office Action dated May 23, 2007, has been reviewed and carefully considered. By this Amendment, claims 1-6, 9-17, 20-26 are pending, claims 1, 6, 23, and 24 are amended. No new matter has been entered by this Amendment. Support for the amendments to the claims 1, 6, 23 and 24 can be found in paragraphs 0055, 0065 and 0066 and in the drawings, for example..

Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

I. THE INDICATION OF ALLOWABLE SUBJECT MATTER

In the Office Action, the Examiner has maintained the objection to claim 21 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the indication of allowable subject matter in the Office Action. In view of the arguments set forth below regarding claim 1, from which claim 21 depends, such claim 21 has not at this time been placed into independent form.

II. THE 35 U.S.C. §102 REJECTION BASED ON BARTON

In the Office Action, claims 1-6, 9-17, 20, 22 and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Barton et al. (U.S. 2002/0059093), hereinafter "Barton." This rejection is respectfully traversed.

In paragraph 6, the Office Action sets forth the basis of the rejection as to claim 1. The Office Action asserts that

"As per claim 1, Barton et al. teaches a method for use in compliance management, comprising: presenting, via a computer network, at least one user with a series of questions relating to at least one business category (See figure 11, paragraphs 0010,

Parent Application
U.S. Application No.: 10/022,438
Attorney Docket No.: 52493.000230

0012-4, 0049, 0051, wherein questions are presented via the network concerning compliance risk); soliciting, via the computer network, a response from the at least one user for each question presented (See paragraphs 0010, 0012-4, 0049, 0051, 0060, wherein the questions are answered); determining a detection index based on the number of responses to each of the series of questions (See paragraphs 0081 and 0084, wherein detection is determined); determining an occurrence index based on the potential consequence of non-compliance (See paragraphs 0007, 0081, and 0084, wherein occurrence index is determined); determining a standard severity risk index based on the expected severity of noncompliance (See paragraphs 0068, 0072-3, 0075, 0081, 0084, wherein severity indexes are considered); and prioritizing, via the computer network, the at least one business category based on the at least one user's responses and at least one total risk score comprising the product of the detection, occurrence, and standard severity risk indices (See paragraphs 0081, 0084-7, wherein a risk score is calculated based on these factors. See also paragraphs 0068-9, 0072, 0081, 0090-1, where risk prioritization numbers are generated to determine the order to handle the risk areas of the business)".

Paragraph 9 of the Office Action responded to previous arguments by Applicant regarding the assertions of paragraph 6. Applicant respectfully resubmits that Barton fails to teach each and every feature of claim 1, and in particular to amended claim 1. Applicant maintains that Barton fails to teach "an occurrence index based on the potential consequence of non-compliance." Applicant appreciates the position presented in the Office Action with regard to this element of claim 1 but such argument is not substantiated by the Barton specification.

The occurrence index recited in claim 1 relates to the "potential consequence of non-compliance" whereas in Barton "an occurrence factor measures the likelihood of occurrence of non-compliance. The likelihood of occurrence measures the frequency of non-compliance in the process..." (see Barton paragraph 0084). Thus, the Barton "occurrence factor" does not address

Patent Application
U.S. Application No.: 10/022,438
Attorney Docket No.: 52493.000230

the consequences but rather the likelihood of an occurrence. To bridge this gap the Office Action equates an "occurrence" in Barton to a "potential failure" in Barton (Office Action cites Barton paragraphs 0007, 0081, and 0084). Such an analogy as set forth in the Office Action is not supportable by the disclosure of Barton. The office action therefore incorrectly convolutes the "occurrence factor" in Barton with the "Potential Failure Effects" as defined in Barton paragraph 0084 and FIG. 16.

Even if the "occurrence factor" in Barton was synonymous with "potential failure" in Barton (which is not admitted), Barton still does not teach the occurrence index of claim 1. In particular, the Office Action compares the "potential consequences" of claim 1 to the "causes and effects of failure. See at least paragraphs 0007, 0038, and 0042." The occurrence index of claim 1 pertains to how "non-compliance" has associated "consequences." In contrast, Barton teaches that when a "Process Step/Input" fails it may lead to "Potential Failure Effects" (see Barton paragraph 0084 and FIG. 16). Thus, the "consequences" of claim 1 and the "effects" of Barton arise from different sources: the "consequence" in claim 1 arises from "non-compliance" whereas the "effect" in Barton results from the failure of a business "Process Step/Input." (see Barton 0084 and FIG. 16).

Applicant further submits that Barton fails to teach the "detection index based on the number of responses to each of the series of questions" as recited in claim 1. Barton refers to a "detection rating" (see Barton claims 24, 54, 98 and 109), "detection ability" (see Barton claim 75 and paragraph 0081), "detection factor" (see Barton claims 5, 50, 55 and paragraph 0084), "detection" (see Barton paragraph 0084) and "ability to detect" (see Barton paragraph 0084). Barton derives these detection concepts "based on a standard rating system which is part of the

Patent Application
U.S. Application No.: 10/022,438
Attorney Docket No.: 52493.000230

knowledge base" (see Barton paragraph 0081). Thus, Barton's "detection" is defined by the knowledge base server whereas the "detection index" as recited in Applicant's claim 1 is based on the number of responses and corresponding answers to each of the series of questions." Thus, the Barton disclosure does not support a conclusion that the Barton's "detection" is based on such, so as to teach the claimed invention.

Thus, Barton fails to teach or suggest the claimed features. Withdrawal of the 35 U.S.C. §102 rejection is respectfully requested.

II. THE 35 U.S.C. §103 REJECTION BASED ON BARTON

In the Office Action, claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton. This rejection is respectfully traversed.

Firstly, Applicant traverses the assertion in the Office Action providing official notice that it is old and well known in the art that "employees and the number of policies are factors that cause occurrences of non-compliance, such as a regulation being violated by a policy or an employee not following a rule." In counterpoint, policies may often be instantiated in order to assure compliance with regulations. Similarly, some employees in organizations are charged with the specific responsibility of ensuring compliance, such as those individuals who would implement Applicant's invention. Therefore, the causal relationship asserted between "employees and the number of policies" and "occurrences of non-compliance" is not supportable as being old and well known in the art.

Secondly, even if the above official notice were appropriate, Barton does not suggest or otherwise motivate one of ordinary skill in the art to use an occurrence index based on the potential consequence of non-compliance "based on the total number of agents or employees

Patent Application
U.S. Application No.: 10/022,438
Attorney Docker No.: 52493.000230

affected by non-compliance" (claim 23) or "based on the total number of policies in force" (claim 24). The Office Action suggests that since employees and policies are factors that cause occurrences of non-compliance, and that Barton discloses an estimator of the "likelihood of non-compliance" that it would therefore be obvious to one of ordinary skill in the art to integrate the "employees" and "policies" factors into that likelihood estimator. However, this combination is not the issue. In order to support a rejection of claims 23 and 24 under 35 U.S.C. 103(a) the official notice as set forth in the Office Action and Barton must suggest a different concept than the Office Action articulates. Barton would have to suggest taking into account the number of agents or employees affected by non-compliance (claim 23) and the total number of policies in force (claim 24) as factors in determining the potential consequences of non-compliance, not the likelihood of non-compliance.

In other words, and as a matter of example, Applicant would not necessarily intend for a large number of employees to translate to more points of failure and/or non-compliance. Rather, the number of employees effects the magnitude or "potential consequence" of non-compliance. Therefore, Applicant respectfully submits that even if such modification as proposed by Examiner were obvious, which is not admitted, such modification of Barton would fail to address the deficiencies of Barton as set forth above.

Accordingly, Applicant submits that claims 23 and 24 are allowable based on their dependency on claim 1, as well as for the further features claims 23 and 24 recite. Withdrawal of the rejection under 35 U.S.C. §103 is requested.

AUG 23 2007

Patent Application
U.S. Application No.: 10/022,438
Attorney Docket No.: 52493.000230

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

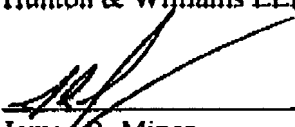
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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